

REMARKS

Claim Status

Claims 11-23 and 43 are pending in the present application, and all claims are thought to be allowable over the cited art.

Rejections Under 35 USC §103(a)

Claims 11, 22 and 43 are understood to be patentable over "Shepherd" (U.S. Patent No. 6,912,510 to Shepherd) in view of "Henson" (U.S. Patent No. 6,167,383 to Henson) and "Pirillo" (U.S. Patent No. 6,990,464 to Pirillo). The rejection under 35 USC §103(a) is respectfully traversed because the Office Action does not show that all the limitations are suggested by the references and does not provide a proper motivation for modifying the teachings of Shepherd with teachings of Henson and Pirillo.

The limitations of the claims are not shown to be suggested by the Shepherd-Henson-Pirillo combination. For example, in claim 11, Henson is not shown to suggest receiving configurations from customers where a configuration is encrypted and loaded into an IC responsive to a customer order. Henson provides the customers with the capability to configure a computer system to be purchased. The configuring includes the capability to customize the product (col. 4, l. 36-52). This customization of the computer system includes selecting a quantity of memory, size of hard drive, monitor type and size, video card, speakers, bundled software etc. (FIGs. 3A-B). Thus, the customization by Henson's customers is not a configuration that is loaded into an IC. The customer's customization information in Henson is used to select components to build a computer system. Those skilled in the art will recognize that this Henson's selection of computer system components does not suggest the storing of configurations and loading one of those configurations into a programmable IC.

Henson does not suggest pulling specified volumes of un-programmed ICs from inventory and loading configuration data into the selected ICs. In the cited teachings of Henson there are no apparent unprogrammed ICs into which the

configuration is loaded. Henson may pull a processor from inventory for building a computer system, but there is no apparent suggestion that customer-provided configuration is loaded into that processor. Henson's customization information is cited as corresponding to the claimed configuration. However, the designation of quantity of memory, size of hard drive, monitor type and size, video card, speakers, bundled software etc. is not loaded into any IC for shipment to the customer. Thus, Henson has no apparent need for the vendor to encrypt a configuration selected by a customer. Henson may load customer-selected software onto the customer-selected hard drive, but those skilled in the art will recognize that the Henson's customers do not provide the software, and the software is not loaded into the processor IC by the vendor.

The Office Action indicates that "the Examiner notes that teachings of Henson solve a similar problem thus are considered as analogous art." However, the Office Action does not indicate what the "problem" is. Shepherd addresses the problem of managing risk between contract buyers and sellers (Background) and provides a method of risk management contract formulation involving a buyer and potential counterparties who submit data regarding probabilities of outcomes (col. 4, l. 17-). Henson deals with the problem of on-line ordering of computer systems (Background) and provides an on-line configurator, a cart, a checkout, and a database (Summary). Thus, there is no apparent similar problem solved, and Henson's teachings are not shown to be relevant to Shepherd's system. Applicant respectfully requests an explanation of the "similar problem" if the rejection is maintained.

The asserted motivation for modifying Shepherd with Henson is unsupported by evidence and improper. The Office Action states that "it would have been obvious ... to modify the teachings Shepherd to include receiving a plurality of configurations ... in order to provide web-based online store having a user interface for enabling a customer to order a customer configured item." However, the Office Action has shown neither that Shepherd lacks this capability nor that Shepherd provides this capability in a manner that could be improved by Henson's teachings. Therefore, the asserted motivation is unsupported by evidence, and if the rejection is maintained Applicant

requests citations to specific elements of Shepherd that would be modified with Henson's teachings.

The limitations of encrypting by the vendor a configuration selected by the customer and loading the encrypted configuration and customer-provided decryption program into the IC are not shown to be suggested by Pirillo. The Office Action cites Pirillo's encryption teachings at col. 4, l. 9-31 as suggesting these limitations.

However, this portion of Pirillo teaches encrypting a book prior to downloading the book to the e-book reader. It is respectfully submitted that the e-book is data that is consumed by an e-book reader, not a configuration for a programmable IC as claimed. In addition, the cited portion of Pirillo does suggest loading any decryption program in IC into which the configuration is loaded. Those skilled in the art will recognize that a key downloaded to an e-book is not suggestive of the loading of a decryption program into a programmable IC (a key does not correspond to a program).

The Office Action indicates that "the Examiner notes that teachings of Pirillo solve a similar problem thus are considered as analogous art." However, the Office Action does not indicate what the "problem" is. As indicated above, Shepherd addresses the problem of managing risk between contract buyers and sellers (Background) and provides a method of risk management/contract formulation involving a buyer and potential counterparties who submit data regarding probabilities of outcomes (col. 4, l. 17-); and Henson deals with the problem of on-line ordering of computer systems (Background) and provides an on-line configurator, a cart, a checkout, and a database (Summary). Pirillo deals with the problem of piracy in the distribution of large, coherent units of information such as books in electronic form. Thus, there is no apparent similar problem solved, and Pirillo's teachings are not shown to be relevant to Shepherd-Henson combination. Applicant respectfully requests an explanation of the "similar problem" if the rejection is maintained.

The asserted motivation for modifying the Shepherd-Henson combination with Pirillo is unsupported by evidence and improper. The Office Action states that "it would have been obvious ... to modify the teachings Shepherd and Henson to include

encrypting ... and loading by the vendor ... in order to provide an encrypted item that could only be decrypted be [sic] the individual who holds access to the decryption key/algorithm/program." However, Shepherd is not shown to benefit from or require encryption since there is no apparent configuration loaded into ICs for shipment to customers. In addition, Henson is not shown to benefit from or require encryption since the customization information used by the vendor to build a computer system would not benefit from being encrypted and loaded into an IC for delivery back to the customer (the customer's customization information could simply be sent in an email rather than loaded into an IC). Therefore, the asserted motivation is unsupported by evidence, and if the rejection is maintained Applicant requests citations to specific elements of Shepherd and Henson that would be modified with Pirillo's teachings.

Claims 22 and 43 include limitations that further refine the limitations of claim 11. Therefore, the limitations are not shown to be suggested by the Shepherd-Henson-Pirillo combination for at least the reasons set forth above.

The rejection of claims 11, 22, and 43 should be withdrawn because a *prima facie* case of obviousness has not been established.

Claims 12-18 are understood to be patentable over the Shepherd-Henson-Pirillo combination as applied to claim 11 above, and further in view of "Clinton" (U.S. Patent No. 5,949,719 to Clinton et al.). The rejection under 35 USC §103(a) is respectfully traversed because the Office Action does not show that all the limitations are suggested by the references and does not provide a proper motivation for modifying the teachings of the Shepherd-Henson-Pirillo combination with teachings of Clinton.

Claims 12-18 depend from claim 11, and the limitations are not shown to be suggested for at least the reasons set forth above. In addition, the asserted motivation is unsupported by evidence and improper. The asserted motivation simply states a function provided by FPGAs. There is no explanation of any aspect of the Shepherd-Henson-Pirillo combination that would benefit from or require FPGAs. Thus, the asserted motivation is unsupported by evidence. Applicant respectfully

requests citations to specific elements of the Shepherd-Henson-Pirillo combination that would be modified with Clinton's teachings if the rejection is maintained.

The rejection of claims 12-18 should be withdrawn because a *prima facie* case of obviousness has not been established.

Claim 19 is understood to be patentable over the Shepherd-Henson-Pirillo combination as applied to claim 11 above, and further in view of "Giddings" (U.S. Patent No. 5,596,282 to Giddings et al). The rejection under 35 USC §103(a) is respectfully traversed because the Office Action does not show that all the limitations are suggested by the references and does not provide a proper motivation for modifying the teachings of the Shepherd-Henson-Pirillo combination with teachings of Giddings.

Claim 19 depends from claim 11; and the limitations are not shown to be suggested for at least the reasons set forth above. In addition, the asserted motivation is unsupported by evidence and improper. The asserted motivation simply states why testing is performed. There is no explanation of any aspect of the Shepherd-Henson-Pirillo combination where testing would be employed to achieve the asserted benefit. Thus, the asserted motivation is unsupported by evidence. Applicant respectfully requests citations to specific elements of the Shepherd-Henson-Pirillo combination that would be modified with Giddings' teachings if the rejection is maintained.

The rejection of claim 19 should be withdrawn because a *prima facie* case of obviousness has not been established.

Claim 20 is understood to be patentable over the Shepherd-Henson-Pirillo combination as applied to claim 11 above, and further in view of "Park" (U.S. Patent No. 6,225,818 to Park et al). The rejection under 35 USC §103(a) is respectfully traversed because the Office Action does not show that all the limitations are suggested by the references and does not provide a proper motivation for modifying the teachings of the Shepherd-Henson-Pirillo combination with teachings of Park.

Claim 20 depends from claim 11, and the limitations are not shown to be suggested for at least the reasons set forth above. In addition, the asserted motivation is unsupported by evidence and improper. The asserted motivation simply states why labeling is useful. There is no explanation of any aspect of the Shepherd-Henson-Pirillo combination where labeling would be employed to achieve the asserted benefit. Thus, the asserted motivation is unsupported by evidence. Applicant respectfully requests citations to specific elements of the Shepherd-Henson-Pirillo combination that would be modified with Park's teachings to achieve the purported benefit if the rejection is maintained.

The rejection of claim 20 should be withdrawn because a prima facie case of obviousness has not been established.

Claim 23 is rejected as being unpatentable over the Shepherd-Henson-Pirillo-Park combination as applied to claim 20 above, and further in view of "Asar" (U.S. Patent No. 6,434,264 to Asar). The rejection is respectfully traversed because the Office Action does not show that all the limitations are suggested by the references and does not provide a proper motivation for modifying the teachings of the Shepherd-Henson-Pirillo-Park combination with teachings of Asar.

Claim 23 depends from claim 20, and the limitations are not shown to be suggested for at least the reasons set forth above. In addition, the asserted motivation is unsupported by evidence and improper. The asserted motivation simply states why labeling with a logo is beneficial. This asserted motivation is unsupported by evidence from any of Shepherd, Henson, Pirillo, or Park. Applicant respectfully requests citations to specific elements of the Shepherd-Henson-Pirillo-Park combination that would be modified with Asar's teachings if the rejection is maintained.

The rejection of claim 23 should be withdrawn because a prima facie case of obviousness has not been established.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Amendments and Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450; on January 5, 2007.

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